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MAY 22 2007

PATENT APPLN. NO. 10/733,198
RESPONSE UNDER 37 C.F.R. §1.111

PATENT
NON-FINAL

REMARKS

Claim 1 has been amended to precisely recite that the releasable engagement of the inside guide member with the outside guide member of the transfer needle assembly of the present invention is released by insertion of a mouth portion of a vial into the inside guide member.

Claims 1-24 are rejected under 35 U.S.C. 102(b)¹ as being anticipated by each of Gustavsson, U.S. Patent No. 4,564,054 (hereinafter: "Gustavsson"); Rowley et al. (U.S. Patent No. 6,171,293) (hereinafter: "Rowley"); and Hoekwater et al. (U.S. Patent No. 5,356,380) (hereinafter: "Hoekwater").

Applicants respectfully submit that none of the references disclose the feature of transfer needle assembly according to claim 1 of the present application that "the engagement between the outside guide member and the inside guide member is released by insertion of a mouth portion of a vial into the inside guide member". This feature is shown in Figs. 9b and 9e of the present application. I.e., engagement between the outside guide member and the inside guide member of the transfer needle assembly of the present invention occurs at the same time as and a result of the

¹ In section (1) of the Action, the Office cites 35 U.S.C. 102(e) as forming a basis of rejection. However, the Action does not include a rejection under 35 U.S.C. 102(e).

insertion of a mouth portion of a vial into the inside guide member.

In the Action, the Office cites Fig. 11 of Gustavsson as disclosing the above feature. The embodiment shown in Fig. 11 of Gustavsson is a fluid transfer system in which the outside member 49 and the inside member 50 are threaded into each other. (See col. 5, lines 21 to 24). In the embodiment of Fig. 11 the inside guide member is not capable of sliding along an inner wall of the skirt portion of the outside guide member from a position where a distal end of the puncture needle is retracted in an inside of the inside guide member, to a position where the distal end of the puncture needle projects outside of the inside guide member, and releasing of the threaded engagement between the outside member and the inside member is not possible by insertion of a vial into the inside member. The threaded members are not released.

The Office cites Figs. 1, 2 and the entire reference of Rowley as disclosing that the engagement between the outside guide member and the inside guide member is releasable by insertion of a mouth portion of a vial into the inside guide member. However, Rowley does not disclose that the engagement between the outside guide member and the inside guide member is released by insertion of a mouth portion of a vial into the inside guide member.

Rowley discloses that the inner tube 4 is held within the outer tube 3 by an outer annular flange 7 on the inner tube 4 engaging an inner annular flange 8 on the outer tube 3. A spring is placed within the outer tube to act on the outer flange 7 in order to maintain the sleeve 2 in an extended position. (col. 3, lines 19 to 27). Release occurs after the venting device of Rowley is fitted over the neck of a bottle and results from the application of force to the venting device towards the rubber stopper of the bottle to move the inner tube against the spring (col. 3, lines 61 to 67). Engagement of the outer tube and inner tube of Rowley is maintained when a bottle is inserted into the device.

In Rowley the mouth of the bottle is not inserted into the inner tube. Therefore, releasing of the engagement between the outer and inner members of Rowley cannot occur by insertion of a mouth portion of a vial into the inside guide member.

The Office cites Figs. 1, 2, 4 and the entire reference of Hoekwater as disclosing that the engagement between the outside guide member and the inside guide member is releasable by insertion of a mouth portion of a vial into the inside guide member. However, Hoekwater also does not disclose that the engagement between the outside guide member and the inside guide member is

released by insertion of a mouth portion of a vial into the inside guide member.

Fig. 1 of Hoekwater clearly shows that a mouth portion of a vial has been inserted into the inner member. However, engagement between the outer member and inner member has not been released. Therefore, insertion of a mouth portion of a vial into the inner member does not release the engagement of the inner member and the outer member in Hoekwater.

A new claim, claim 25, has been added to the application for consideration by the Office. Claim 25 corresponds to claim 2 rewritten in independent form. None of Gustavsson, Rowley and Hoekwater discloses the elements of the transfer needle assembly as recited in new claim 25. More particularly, none of Gustavsson, Rowley and Hoekwater discloses a transfer needle assembly including an outside guide member having a top surface and a skirt portion and a tubular inside guide member that is positioned in the outside guide member, wherein the skirt portion of the outside guide member includes an annular projection provided in an inner wall of a distal end of the skirt portion, a plurality of slits extending in an axial direction of the outside guide member formed in a portion of the skirt portion on a proximal end side with respect to the annular projection, and a plurality of flexible engaging claws

formed between pairs of the plurality of slits, the plurality of flexible engaging claws inclining toward an inside of the outside guide member in a distal end direction; wherein a proximal end side of the inside guide member includes an annular projection provided in an outer wall of a proximal end, a plurality of slits extending in an axial direction of the inside guide member formed in a proximal end portion of the inside guide member corresponding to the plurality of engaging claws, and a plurality of flexible pushing claws formed between pairs of the plurality of slits, the plurality of flexible pushing claws inclining toward an inside of the inside guide member in a proximal end direction; and wherein, at the position where the distal end of the puncture needle is retracted in the inside of the inside guide member, the engaging claws and the proximal end of the inside guide member are engaged with each other and the annular projection of the outside guide member and the annular projection of the inside guide member are engaged with each other, and by inserting the mouth portion of the vial into the inside guide member, the pushing claws push the engaging claws to the outside, causing the engaging claws to deform and release the engagement between the outside guide member and the inside guide member.

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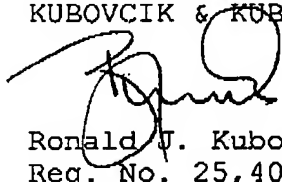
Removal of the 35 U.S.C. 102(b) rejections of claims 1-24 and a notice of allowability of claims 1-25 are believed to be in order and are respectfully requested.

Form PTO-2038 is attached hereto for payment of the fee for one excess total claim (\$50.00).

The foregoing is believed to be a complete and proper response to the Office Action dated February 22, 2007, and is believed to place this application in condition for allowance.

In the event that this paper is not considered to be timely filed, applicant hereby petitions for an appropriate extension of time. The fee for any such extension and any additional fees may be charged to our Deposit Account No. 111833.

Respectfully submitted,
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